

## REMARKS

Applicant kindly acknowledges the Examiner's indication that claim 7 is allowable as amended herein. Reconsideration of the application as amended is respectfully requested. Initially the provisional double patenting rejection is noted. As to the rejection based upon 35 U.S.C. § 112, claim 1 has been amended to address the concerns raised by the Examiner. No new matter has been added. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. Thus claims 1-8 remain in the present application.

On the merits, claims 1-6 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Steiner embodiment shown in Figure 2 (USP 5,393,384) in view of Eklund's disclosure at the paragraph bridging columns 5-6 (USP 5,298,124).

Amended independent claim 1 now recites in part "wherein the transfer of said soft tissue web from said shoe press nip directly to the Yankee cylinder is improved due to said transfer belt's web-contacting surface having a pressure-sensitive resettable degree of roughness." (Emphasis added).

It is the examiner's position at page 5 of the office action that it was obvious to modify Steiner's belt in view of Eklund. Applicants do not agree. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992). Applying the law to the instant facts, Steiner in Figure 2 and lines 8-27 of column 3 fails to suggest that the belt (labeled as element 2) performs less than reliably, or that modification would otherwise be desirable. On the contrary, the cited portions of Steiner discloses that the belt 2 performs its purported purpose adequately and without negative incident. Accordingly, Steiner fails to provide the necessary incentive or motivation for

modifying the reference teachings, as required by *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989).

In addition, Eklund fails to suggest that a belt intended for pressing in a press section and usable for transfer of a paper web from the press section to a dryer fabric (Eklund at line 7, col. 6), would also be usable in transferring a soft tissue web from a shoe press nip directly to a Yankee cylinder, as claimed in the present application. In a Yankee cylinder, the conditions are, in fact and as is known, quite different from those in a press nip. In a Yankee cylinder, there is no pressing of the soft tissue web for direct dewatering but it is instead a matter of supporting the soft tissue web against the outer surface of the Yankee cylinder, such that the fibers of the soft tissue web adhere to the surface of the cylinder. Yet precisely this effect is achieved by Applicant's claimed transfer belt, which cannot be achieved or is achieved to a substantially smaller extent by a transfer belt according to Steiner for the reason described above (see also, for example, Figure 1 and page 4 of the present Application).

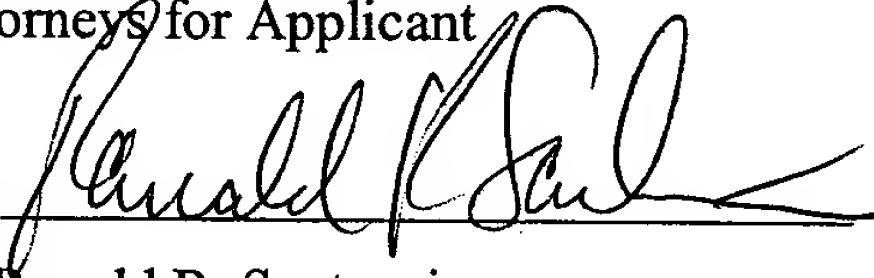
Accordingly, because both the suggestion of the claimed invention and the expectation of success are found only in Applicant's disclosure, and nowhere in Steiner and Eklund, the obviousness rejection is improper. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Therefore, it is concluded that claim 1 and claims 2-6 and 8 dependent therefrom, are unobvious over the proposed combination of Steiner and Eklund. In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and early and favorable consideration thereof is solicited.

It is to be appreciated that the foregoing comments concerning the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the

event, that the Examiner disagrees with any such opinions, it is requested that the Examiner indicate where, in the reference or references, there is the bases for a contrary view.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicant

By: 

Ronald R. Santucci  
Reg. No. 28,988  
Tel. (212) 588-0800

**VERSION WITH MARKINGS SHOWING CHANGES MADE**

1. (Three Times Amended) In a soft tissue paper machine having an essentially impermeable transfer belt for conducting a soft tissue web through a shoe press nip in the press section of the paper machine, and from the shoe press nip to a Yankee cylinder in the dryer section of the paper machine in a closed draw, which Yankee cylinder forms, together with a transfer means, a transfer nip transferring the soft tissue web from the transfer belt to the Yankee cylinder, the improvement comprising an essentially impermeable transfer belt having a carrier and an elastically compressible polymer layer on its side facing the paper web, the polymer layer having a hardness between 50 and 97 Shore A and having a web-contacting surface which has a pressure-sensitive resettable degree of roughness, the web-contacting surface having a degree of roughness in a non-compressed state of  $R_z = 2-80 \mu\text{m}$ , measured according to ISO 4287, Part I, and a lower degree of roughness of  $R_z = 0-20 \mu\text{m}$  when the polymer layer is compressed by a linear load of 20-220 kN/m applied to the essentially impermeable transfer belt as measured in a non-extended press nip,

wherein the transfer of said soft tissue web from said shoe press nip directly to the Yankee cylinder is improved due to said transfer belt's web-contacting surface having a pressure-sensitive resettable degree of roughness[, as compared with a transfer belt with a web-contacting surface not having a pressure-sensitive resettable degree of roughness].

7. (Four Times Amended) [An improvement as claimed in claim 1,] In a soft tissue paper machine having an essentially impermeable transfer belt for conducting a soft tissue web through a shoe press nip in the press section of the paper machine, and from the shoe press nip to a Yankee cylinder in the dryer section of the paper machine in a closed draw, which Yankee cylinder forms, together with a transfer means, a transfer nip transferring the soft tissue

web from the transfer belt to the Yankee cylinder, the improvement comprising an essentially impermeable transfer belt having a carrier and an elastically compressible polymer layer on its side facing the paper web, the polymer layer having a hardness between 50 and 97 Shore A and having a web-contacting surface which has a pressure-sensitive resettable degree of roughness, the web-contacting surface having a degree of roughness in a non-compressed state of  $R_z = 2-80 \mu\text{m}$ , measured according to ISO 4287, Part I, and a lower degree of roughness of  $R_z = 0-20 \mu\text{m}$  when the polymer layer is compressed by a linear load of 20-220 kN/m applied to the essentially impermeable transfer belt as measured in a non-extended press nip,

wherein the transfer of said soft tissue web from said shoe press nip to the Yankee cylinder is improved due to said transfer belt's web-contacting surface having a pressure-sensitive resettable degree of roughness, and wherein the polymer layer is embossed to produce embossed soft tissue.